

### **REMARKS**

Favorable reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks. This Amendment and Reply to the Office Action, mailed June 14, 2005, is being filed with a 2-month extension of time fee payment, therefore extending the response period to November 14, 2005.

Claims 1-20 are pending in the subject application, with amended Claim 1 being in independent format. Applicants submitted a Preliminary Amendment along with the subject Patent Application on September 25, 2001. In the Preliminary Amendment, Claims 1-11 were amended and new Claims 12-20 were added. In the Office Action mailed June 14, 2005, it appears that the Examiner examined Claims 1-11 from the application as filed, instead of amended Claims 1-11 and newly added Claims 12-20 as presented in the Preliminary Amendment. Applicants respectfully request that pending Claims 1-20 be considered in light of this Amendment and Reply.

Claim 1 has been amended to recite an apparatus for dispensing strips of adhesive tape, comprising a housing with a take-up device taking up an adhesive tape roll; at least one transporting roll provided with a circumferential groove; at least one folding roll provided with a circumferential bulge; a first toothed rack connected with a lever, which drives the at least one transporting roll; and a cutting means, which can be activated by a second toothed rack via a first gear wheel, wherein the first toothed rack is arranged on one side of the lever and the second toothed rack is arranged on the opposite side of the lever, wherein at least one of the toothed racks is guided by a lower guide means provided between a lower part of the housing and a lower end of the at least one toothed rack, wherein at least one of the toothed racks is guided by an upper guide means provided between an upper part of the at least one toothed rack and the lever in such a manner that during the downward motion of the lever, the first toothed rack indirectly engages the at least one transporting roll and the second toothed rack engages the first gear wheel, and wherein the first and second toothed racks are disengaged for an upward motion.

Claims 2-11 have been amended to conform to U.S. patent practice. Claims 12-20 recite subject matter previously recited in multiple dependent claims presented in the application as filed. All of the claim amendments are presented for purposes of conforming the claims to U.S. patent practice, and not for reasons relating to patentability. It is urged that support for all the

above amendments may be found throughout the specification as originally filed and that none of the amendments constitute new matter or give rise to prosecution history estoppel.

### ***Drawings***

Figure 1 is objected to because item “15” is not mentioned in the description. Applicants have amended the specification to add item “15”, which designates a “toothed portion 15 over a circular sector” (page 2, lines 28-29 of the specification as filed).

Figures 1 and 2 are objected to because hidden lines are not used to show which structures are in front or behind. Figures 5a-d and Figures 6a-d are objected to because the figures contain lines or arrows to join two separate drawings. Also, the Examiner recommends that Figures 5a-d and Figures 6a-d be labeled as Figures 5 and 6, respectively.

The amendments to the drawings are reflected in the Replacement Sheet attached herewith. Applicants respectfully submit that the objections to the drawings may thus be properly withdrawn.

### ***Specification***

The Specification is objected to because the text of the specification was not provided with the appropriate section headings according to 37 C.F.R. §1.77(b). Also, the specification is objected to because of inappropriate designation of numerical references.

Applicants have amended the specification to overcome the objections as stated above. Applicants respectfully submit that the objections to the specification may thus be properly withdrawn.

### ***Claim Objections***

The Examiner states that the numbering of claims is not in accordance with 37 C.F.R. §1.126, which requires the original numbering of claims to be preserved throughout the prosecution. Specifically, the first independent claim was labeled as Claim 12 in the application as filed. Also, Claims 1, 2, 4, 5, 6, 8, and 11 are objected to because the claims contain inappropriate numerical references and claim language.

Applicants have amended the claims to delete the numerical references and to correct the claim language. Applicants respectfully submit that the claim objections may thus be properly withdrawn.

***Claim Rejections – 35 U.S.C. §112, first paragraph***

Claims 1-11 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner states that on page 2, lines 28 and 30 of the specification as filed, the phrases “a short sliding plate 13” and “a longer sliding guide 20” are unclear.

Applicants have amended the specification to replace the phrase “a short sliding plate 13” with “a short guide groove 13”, and the phrase “a longer sliding guide 20” was amended to read “a longer arched guide groove 20”.

Applicants respectfully submit that the claim rejections under 35 U.S.C. §112, first paragraph, may thus be properly withdrawn.

***Claim Rejections – 35 U.S.C. §112, second paragraph***

The Examiner has rejected Claims 1-11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 1, 2, 8, 10, and 11 were rejected based on improper and unclear claim language, as well as insufficient antecedent basis.

The claims have been amended to overcome the rejections. Specifically, in Claim 1, the phrase “or the like” has been removed; the phrase “the two toothed racks are provided on both sides of the lever” has been amended to read “the first toothed rack is arranged on one side of the lever and the second toothed rack is arranged on the opposite side of the lever”; the phrases “a lower sliding guide plate” and “an upper sliding guide plate” have been amended to read “a lower guiding means” and “an upper guiding means”, respectively; the phrase “an upper sliding guide plate on the lever” has been amended to read “...at least one of the toothed racks is guided by a lower guide means provided between a lower part of the housing and a lower end of the at least one toothed rack, wherein at least one of the toothed racks is guided by an upper guide means provided between an upper part of the at least one toothed rack and the lever....”; the

phrase “the toothed rack” has been amended to read “first and second toothed racks”; and sufficient antecedent basis are now provided for the limitations “the lower part” and “the housing” in Claim 1.

Applicants respectfully submit the phrase “rack is disengaged for the upward motion” is clearly supported by the specification as filed. On page 4, lines 18 to 22 of the specification as originally filed, the toothed rack 14 is described as being disengaged for an upward movement. Also, if the toothed rack is moved downwards only partially, i.e., at an intermediate position as depicted in Fig. 5b, the toothed rack 14 will be disengaged from the gears 27 and 28 during upward movement (see page 4, lines 25 to 27).

Claim 2 has been amended to read “....wherein the at least one transporting roll is axially connected to a gear wheel, which can be engaged with the first toothed rack” Claim 8 has been amended to read “.... wherein the lever arm is rotatably supported in the housing at its end opposite the knife, and the lever arm is provided with a leading edge....” Claim 11 has been amended to read “....wherein the housing with the take-up device taking up an adhesive tape roll, the at least one transporting roll, and the folding roll are mounted....”

Regarding Claim 10, cam 11 is shown adjacent to tape 45 in Figure 2 as originally filed. Cam 11 is used to transport a severed strip of adhesive tape 45.

Applicants respectfully submit that the claim rejections under 35 U.S.C. §112, second paragraph, may thus be properly withdrawn.

#### ***Claim Rejections – 35 U.S.C. §102(b)***

Claims 1-4, 7, and 9-11 are rejected, under 35 U.S.C. §102(b) as being anticipated by *Palson et al.* (U.S. Patent No. 3,466,963). This rejection is respectfully traversed, particularly in view of the above amendments and the following remarks.

Regarding Claim 1, the Examiner alleges that *Palson et al.* teaches an apparatus for dispensing strips of adhesive tape with a take-up device (12) taking up a tape roll (11), at least one transporting roll (17) provided with a circumferential groove (14), a folding roll provided with a circumferential bulge (18), a first toothed rack (21, 74) connected with a lever (2, 71), a cutting means (31, 79) that is activated by a second toothed rack (74) via a first gear wheel (22, 76), the two toothed racks are provided on both sides of the lever (Fig. 11), at least one of the

toothed racks is guided in a lower sliding guide plate provided in the lower part of the housing (25) and an upper sliding on the lever (Fig. 2) in such a manner that during the downward motion of the lever the toothed rack indirectly engages the transporting roll and the first gear (Figs. 2 and 10), and the rack is disengaged for the upward motion (Fig. 10).

As reflected in the above claim amendments, Claim 1 has been amended to recite: “an apparatus for dispensing strips of adhesive tape, comprising a housing with a take-up device taking up an adhesive tape roll; at least one transporting roll provided with a circumferential groove; at least one folding roll provided with a circumferential bulge; a first toothed rack connected with a lever, which drives the at least one transporting roll; and a cutting means, which can be activated by a second toothed rack via a first gear wheel, wherein the first toothed rack is arranged on one side of the lever and the second toothed rack is arranged on the opposite side of the lever, wherein at least one of the toothed racks is guided by a lower guide means provided between a lower part of the housing and a lower end of the at least one toothed rack, wherein at least one of the toothed racks is guided by an upper guide means provided between an upper part of the at least one toothed rack and the lever in such a manner that during the downward motion of the lever, the first toothed rack indirectly engages the at least one transporting roll and the second toothed rack engages the first gear wheel, and wherein the first and second toothed racks are disengaged for an upward motion.”

Applicants respectfully submit that *Palson et al.* does **not** teach an apparatus having one of the toothed racks being guided by a lower guide means and by an upper guide means, in such a manner that during downward motion of the lever, the first toothed rack indirectly engages the at least one transporting roll and the second toothed rack engages the first gear wheel, and wherein the first and second toothed racks are disengaged for an upward motion.

In *Palson et al.*, with respect to Figs. 1 to 4, a rack 21 is fixed to the top in such a position as to engage a pinion 22 mounted for rotation about the axle of the upper roller. The pinion is pressed against the gear 19 by a spring 23 (Fig. 4) and cooperating retched teeth 24 are provided on the touching faces of the pinion and gear to turn the gear only in a direction to dispense tape, permitting the pinion to slip relative to the gear, after a dispensing stroke, when the rack is rising with the top as it returns to its normal position (*see col. 4, lines 15-23*).

The similar ratchet mechanism is shown in Fig. 9 and in Fig. 10 in *Palson et al.* Thus, it is clear that the rack as taught by *Palson et al.* is continuously engaged with the gear during the rack's rising or upwards motion.

Moreover, a cutter blade 31 (Fig. 5) is provided in the first embodiment of *Palson et al.*, which is operated by the top 2 of the tape dispenser mechanism (see col. 4, lines 49 to 58). In the second embodiment as shown in Fig. 10, an upper cutter blade 79 is provided, which is also operated by a lever 71 attached to the top of the housing towards a lower cutting blade 77 (see col. 7, lines 5 to 35).

Thus, a cutting means which can be activated by a second toothed rack as taught by the present invention is **not** disclosed in *Palson et al.* *Palson et al.* therefore does **not** disclose each element of the claimed invention and does not anticipate amended Claim 1.


It is urged that Claims 1-4, 7, and 9-11 are not anticipated by *Palson et al.* and that the present rejection of the claims under 35 U.S.C. §102(b) may thus be properly withdrawn.

Applicants note that the Examiners states that Claims 5, 6, and 8 have not been rejected over prior art and may or may not be readable over the prior art, and that the patentability of Claims 5, 6, and 8 cannot be determined at this time in view of issues under 35 U.S.C. §112.

### ***Conclusion***

In view of the above amendments and remarks, applicants believe that they have addressed all of Examiner's concerns. Early consideration and allowance of all the pending claims is respectfully requested.

Respectfully submitted,

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